UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
HO, CHUONG T

ART UNIT	PAPER NUMBER
2664	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/192,583	MOTOYAMA, TETSURO
	Examiner	Art Unit	
	CHUONG T. HO	2664	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*18 February 2005*</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-53* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-53* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/14/05</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

1.   The amendment filed 02/18/05 have been entered and made of record.

2.   Claims 1-53 is pending.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-3, 8, 12, 23, 24, 25, 31, 34, 45, 46, 48, 50-51 are rejected under 35

U.S.C. 102(e) as being anticipated by Lazaridis et al. (U.S.Patent No. 6,219,694 B1).

In the claims 1, 23, Lazaridis et al. discloses determining a system for pushing

information from a host system (a computer) to a mobile data communication device (a

business device) upon sensing a triggering event is disclosed (see abstract). A

redirector program operating at the host system (a computer) enables a user to

continuously redirect certain user's mobile data communication device upon detecting

the one or more user-defined triggering events has occurred (see abstract); A list of

message characteristics that determine whether a message is to be redirected. If

activated, the preferred list mode causes the redirector program 12 to operate like a

filter, only redirecting certain user data items based on whether the data item was sent

from a sender on the preferred list or has certain message characteristics that if present

will trigger or suppress redirection of the message (see col. 8, lines 9-11); comprising:

- Receiving an electronic mail message by a computer; determining whether a content of the message (the word "instruction" is the characteristic of the e-mail) is for a user of the computer (user's desktop system 10) or for an attached device (a mobile data communication device) associated with the computer by detecting a characteristic of the e-mail, the attached device being a business office device (a mobile data communication device) including a processor (see abstract, col. 8, lines 9-11);

- transmitting a communication from the computer (user's desktop system 10) to the attached device (a mobile data communication device) if the determining that the received message is for that attached device, (see abstract, determining a system for pushing information from a host system (a computer) to a mobile data communication device (a business device) upon sensing a triggering event is disclosed (see abstract). A redirector program operating at the host system (a computer) enables a user to continuously redirect certain user's mobile data communication device upon detecting the one or more user-defined triggering events has occurred (see abstract); (see col. 8, lines 9-11, a list of message characteristics that determine whether a message is to be redirected. If activated, the preferred list mode causes the redirector program 12 to operate like a filter, only redirecting certain user data items based on whether the data item was sent from a sender on the preferred list or has certain message characteristics that if present will trigger or suppress redirection of the message);

- operating the processor of the attached device (a mobile data communication device) in response to the communication (once the message (A or B) is received by the mobile device 24), the outer envelope B is removed and the original message A is placed in the secondary memory store within the mobile device 24. By repacking and removing the outer envelope in this manner, the present invention causes the mobile computer 24 to appear to be at the same physical location as the host system 10, thus creating a transparent system).

5.   In the claims 2, 24, 34, Lazaridis et al. discloses determining whether the received message includes instructions (the word "instruction" is the characteristic of the e-mail) for operating the device or whether the received message which has been received has been received has a user of the computer as an end recipient (see abstract, col. 8, lines 9-11).

6.   In the claims 3, 25, Lazaridis discloses displaying, after the receiving step, a message to the user indicating the electronic mail message contains information to be forward to the device, wherein the determining step comprises: determining by a user reading the displayed message whether the received message includes instructions (the word "instruction" is the characteristic of the e-mail) is for operating the device (see abstract, col. 8, lines 9-11).

7.   In the claim 8, Lazaridis et al. discloses receiving an Internet electronic mail message (see abstract, col. 8, lines 9-11, figure 1).

8.   In the claim 12, Lazaridis et al. discloses determining whether the message is for the user (the user's desktop system 10) or for the attached device automatically by

detecting a characteristic (the word "instruction" is the characteristic of the e-mail) (see abstract, col. 8, lines 9-11).

9.   In the claim 45, Lazaridis et al. discloses receiving data from the device, in response to the step of operating the processor; creating an electronic mail message (repackage the user-selected data items in an electronic wrapper prior to push the data items to the mobile device) by computer (the user's desktop system 10) including the data which has been received; and transmitting over the Internet the electronic mail message generated by the computer.

14.   In the claims 46, 31, 50, 51, Lazaridis et al. discloses executing, by a device driver of the computer, commands for at least one of controlling and monitoring the device (see col. 1, lines 11-15, the system and method of the present invention provide an event-driven redirection computer program ("redirector program") operating at the host system, which, upon sensing a particular user-defined event has occurred, redirects user-selected data items from the host system to the user's mobile data communication device (Business office device including CPU) (col. 7, lines 14-15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1.   Claims 4, 9, 10, 13-15, 26, 27, 48, 32, 35-37, 52 are rejected under 35 U.S.C.

103(a) as being unpatentable over Lazaridis et al. (U.S.Patent No. 6,219,694 B1) in

view of Kuwabara (U.S.Patent No. 6,065,136).

In the claims 4, 48, 26, 32, Lazaridis et al. discloses the limitations of claim 3

above.

However, Lazaridis et al. is silent to disclosing executing a command which the

step of transmitting to be performed

Kuwabara, see figure 1, discloses receiving an electronic mail message by a computer

(the provider 5); determining whether the received e-mail includes instruction

(addressee mail code column ML1 that it has been addressed to the marker's provider

(a business office device)) for operating a device (the marker's provider 8) associated

with computer (the provider 5), the device (the marker's provider 8) being a business

office device including a processor; comprising:

Executing a command which causes the step of transmitting to be performed (see col.

5, lines 32-35, when this electronic mail from User A is received, the provider 5 (the

computer) identifies from its addressee mail code column ML1 (execute program code)

that it has been addressed to the marker's provider 8 (the business office devices)

through a telephone line T4 considered to be the optimum route).

Both Lazaridis and Kuwabara discloses determining whether received electronic mail

message includes characteristic "instructions". Kuwabara discloses executing a

command which causes the step of transmitting to be performed. Thus, it would have

been obvious to one of ordinary skill in the art at the time of the invention to modify the

system of Lazaridis with the teaching of Kuwabara to executing a command which

causes the step of transmitting to be performed in order to transmit a communication

from the computer (associated with business office device) to the device. Therefore, the

combined system would have been enable the combined system to carry out diagnosis

of troubles.

2.   In the claims 9, 27, Lazaridis discloses the step of executing a command

comprises transmitting information to a device driver executing within the computer; and

step of transmitting is performed using the device driver (see col. 1, lines 13-16).

3.   In the claim 10, Lazaridis discloses receiving, by the device, the communication

transmitted from the computer; and transmitting parameters from the device to the

computer, in response to the communication which has been received by the device

(see col. 6, lines 42-45).

4.   In the claims 13, 35, 36, 37, 52, Kuwabara discloses determining that the

message for operating the attached device automatically by detecting a code within the

message (see col. 5, lines 32-35, when this electronic mail from User A is received, the

provider 5 (the computer) identifies from its addressee mail code column ML1 (execute

program code) that it has been addressed to the marker's provider 8 (the business

office devices) and serves to transmit it to the address provider 8 (the business office

devices) through a telephone line T4 considered to be the optimum route).

5.   In the claim 14, Kuwabara discloses determining that the message for operating

the attached device automatically by detecting a code within the message (see col. 5,

lines 32-35, when this electronic mail from User A is received, the provider 5 (the

computer) identifies from its addressee mail code column ML1 (executing program

code) that it has been addressed to the marker's provider 8 (the business office

devices) and serves to transmit it to the address provider 8 (the business office devices)

through a telephone line T4 considered to be the optimum route).

6.   In the claim 15, Kuwabara discloses determining that the message is for the

attached device automatically by detecting a code within the message (see col. 5, lines

32-35, when this electronic mail from User A is received, the provider 5 (the computer)

identifies from its addressee mail code column ML1 (executing program code) that it

has been addressed to the marker's provider 8 (the business office devices) and

serves to transmit it to the address provider 8 (the business office devices) through a

telephone line T4 considered to be the optimum route).

Claim Rejections - 35 USC § 103

7.·   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 5, 6, 7, 11, 16, 17, 27, 28, 29, 30, 47, 33, 38, 39 are rejected under 35

U.S.C. 103(a) as being unpatentable over the combined system (Lazaridis – Kuwabara)

in view of Zerber (U.S.Patent No. 5,951,636).

In the claims 5, 6, 7, 27, 33, the combined system (Lazaridis – Kuwabara)

discloses the limitations of claim 1 above.

However, the combined system (Lazaridis – Kuwabara) is silent to disclosing the executing program code of a file which is attached to the message by a manual action by the user.

Zerber discloses executing program code of a file which is attached to the message by a manual action by the user (see abstract).

Both Lazaridis, Kuwabara, and Zerber discloses e-mail message. Zerber discloses executing program code of a file which is attached to the message by a manual action by the user. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system (Lazaridis – Kuwabara) with the teaching of Zerber to executing program code of a file which is attached to the message by a manual action in order to limit to only those messages the user want to downloaded.

9.   Regarding to claims 6, 29, Zerber et al. discloses executing the program code of the file by pointing, using a pointing device and graphical user interface, to an object representing the file (see abstract).

10.   Regarding to claims 7, 28, Zerber et al. discloses executing the code by pressing a button while pointing the object representing the file (see abstract).

11.   Regarding to claim 11, Zerber et al. performing a mechanical action by the device, in response to the communication which has been received by the device (see abstract).

12.   Regarding to claims 16, 17, 30, 38, 39, Zerber et al. discloses the determining

step is performed in response to a receipt of an incoming electronic mail message (see

col. 2, lines 30-65).

Claim Rejections - 35 USC § 102

13.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14.   Claims 18-22, 40-44 are rejected under 35 U.S.C. 102(e) as being anticipated by

Lazaridis et al. (U.S.Patent No. 6,219,694 B1).

       Regarding to claims 18, 40, see figure 1, Lazaridis et al. discloses transmitting

information from a device (a mobile data communication device) to a computer (a host

system) associated with the device (a mobile data communication device), the device

(mobile data communication device) being a business office device including a

processor (see figure 1, see abstract, col. 8, lines 9-11); comprising:

- Processing the information by a device driver within the computer (see col. 1,

    lines 11-15, the system and method of the present invention provide an event-

    driven redirection computer program ("redirector program") operating at the host

    system, which, upon sensing a particular user-defined event has occurred,

redirects user-selected data items from the host system to the user's mobile data

communication device (Business office device including CPU);

- Transmitting, by the computer (a host system), an electronic message

  corresponding to the information (see col. 8, lines 9-11);

- Wherein the device driver (see col. 1, lines 11-15) is configured to control

  operations of the device.

15.   Regarding to claims 19, 41, Lazaridis et al. discloses transmitting the information

from the device driver to a messaging application program interface (MAPI) of the

computer; and processing the information by the MAPI, wherein the step of transmitting

the electronic mail message comprises transmitting the electronic mail message

corresponding to the information which has been processed by the MAPI (see col. 7,

lines 31-45).

16.   Regarding to claims 20, 42, Lazaridis et al. discloses the computer is a message

transfer agent, the step of transmitting information from the device transmit the

information from the device directly to the computer which is the message transfer

agent, and the step of transmitting the electronic mail message transmits the electronic

mail message using a TCP connection from the computer which is a message transfer

agent (see col. 8, lines 32-35).

17.   Regarding to claims 21, 43, Lazaridis et al. discloses creating a file

corresponding to the information; and writing the file to a mail spoon directory of the

computer; and wherein the step of transmitting the electronic mail message comprising

transmitting the electronic mail message corresponding to the information using the file stored in the mail spool directory (see col. 7, lines 35-37).

18.   Regarding to claims 22, 44, Lazaridis et al. discloses creating and writing comprising creating a plurality of files and writing the plurality of files in the mail spool directory; and transmitting the electronic mail message using each of the plurality of files stored in the mail spoon directory (see col. 7, lines 31-40).

Claim Rejections - 35 USC § 103

19.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

20.   Claims 47, 49, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazaridis et al. (U.S.Patent No. 6,219,694 B1) in view of Miyachi (U.S.Patent No. 6,108,492).

Regarding to claims 47, 49, 53, Lazaridis et al. discloses the limitations of claim 1 above.

However, Lazaridis et al. is silent to disclosing the business office device at least one of generates an image on a recording medium and scans an image on a recording medium.

Miyachi discloses wherein the business office device at least one of generates an image on a recording medium and scans an image on a recording medium (see col. 2, lines 27-35).

Both Lazaridis, Miyachi disclose the office deive. Miyachi discloses the business office device at least one of generates an image on a recording medium and scans an image on a recording medium. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Lazaridis with the teaching of Miyachi to provide the business office device at least one of generates an image on a recording medium and scans an image on a recording medium in order to carry out remote diagnose of troubles in business communication devices.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHUONG T. HO whose telephone number is (571) 272-3133. The examiner can normally be reached on 8:00 am to 4:00 pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

05/11/05

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SUPERVISORY PATENT EXAMINER